

REMARKS

Reconsideration and allowance of this application, as amended, is respectfully requested.

This Amendment is in response to the Office Action dated January 12, 2005. By the present amendment, the Specification has been amended to update the status of the parent applications, as required in the objection to the Specification set forth on page 2 of the Office Action. Accordingly, removal of this objection is respectfully requested. Also by the present amendment, claims 1 and 5 have been amended for clarification, as will be discussed below.

Reconsideration and removal of the 35 USC §102 rejection of claims 1-3 and 5 based on the Quinn USP 3,144,704 is respectfully requested. By the present amendment, claim 1 has been amended to further clarify features of the invention concerning the relationship between the first and second conductor layers and a bonding member which bonds the first conductor layer to an insulator plate. In particular, independent claim 1 now specifically defines that the first conductor layer is bonded to a surface of the insulator plate using a bonding member whereas the second conductor layer which faces the first conductor layer is not bonded to the insulator plate by the bonding member. In addition, claim 1 now clearly defines that the first and second conductor layers are electrically connected to one another. By virtue of this arrangement, if voids or an intentional gap is provided between the conductor layer and the insulator plate, the electrical connection of the first conductor plate to the second conductor plate can help to avoid partial discharges which can occur within any such voids or gap portions.

It is respectfully submitted that the Quinn patent fails to teach either this claimed structure or the above-noted operational advantage obtained thereby. In particular, it is respectfully submitted that the claimed bonding arrangement of the first conductor layer onto a surface of the insulator plate, the claimed feature that the second conductor layer is not bonded to the insulator plate using the bonding member and the electrical connection of the first and second conductor layers sets forth a combination of features which is neither taught nor suggested by Quinn. In addition, by virtue of lacking this claim structure, Quinn will fail to obtain the advantage of preventing undesirable discharges within voids or intentional gaps which may exist between the first conductor plate and the insulator (which is achieved by the claimed invention of amended claim 1). Therefore, reconsideration and allowance of the amended independent claim 1 and its dependent claims 2-5 is respectfully requested.

Reconsideration and allowance of claim 6 over the 35 USC §103(a) rejection also based on the Quinn patent is also respectfully requested. In the Office Action, it is recognized that the Quinn reference fails to teach the claimed relationship set forth in the last paragraph of claim 6, however, it is stated that this would have been obvious to "optimize the relationship of the dielectric constant of the dielectric layer to the dielectric constant of the insulator plate." Applicants respectfully request reconsideration of this, particularly considering the requirements of MPEP §2143.01 concerning modifications of prior art teachings. As noted in MPEP §2143.01, the Prior Art itself must suggest the desirability of the claimed invention. In particular, it is set forth there that:

"obviousness can only be established by combining or modifying the teachings of the Prior Art to produce to produce the claimed invention

where there is some teaching, suggestion or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art."

Clearly there is no teaching, suggestion or motivation within the Quinn reference itself for the detailed relationship set forth in the last paragraph of claim 6. Further, there has been no evidentiary showing that this would qualify as "knowledge generally available to one of ordinary skill in the art." As required in MPEP §2144.03:

"It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based."

This section of the MPEP refers to the case of *In re Lee*, 61 USPQ 2D 1430 (CAFC) which states:

"conclusory statements such as those here provided do not fill the agencies obligation ... the board can not rely on conclusory statements when dealing with particular combinations of Prior Art and specific claims, but must set forth the rationale on which it relies. "

With particular regard to the motivation for modifying a reference, the *In re Lee* case specifically sets forth:

"This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill in the art would have been led to this combination of references, simply to "use that which the inventor has taught against its teacher." (61 USPQ 2D 1434).

Accordingly, in light of the lack of any evidentiary support for the statement that it would be obvious to optimize the relationship of the dielectric constant, reconsideration and removal of this basis of rejection is respectfully requested.

As a further aspect of this, although the Office Action has not specifically stated that it relies on common knowledge in the art or what is "well known" in the art, it appears that this may be the underlying rationale of the statement that it would

be obvious to optimize the relationships of the dielectric constants. Concerning this, references made to MPEP §2144.03 which notes that such reliance should only be used "in limited circumstances." More specifically, MPEP §2144.03 states that "these circumstances should be rare" and that the requirement is as follows:

"The notice of facts beyond the record which may be taken by Examiner must be "capable of such instant and unquestionable demonstration as to defy dispute." "

It is respectfully submitted that, in the present instance, certainly no demonstration has been given that the detailed relationship set forth in the last paragraph of claim 6 is capable of "instant and unquestionable demonstration" as being well known or common knowledge. Therefore, it is respectfully submitted that the requirements of MPEP §2144.03 have not been met and reconsideration and allowance of claim 6 is respectfully requested.

If the Examiner believes that there are any other points which may be clarified or otherwise disposed of either by telephone discussion or by personal interview, the Examiner is invited to contact Applicants' undersigned attorney at the number indicated below.

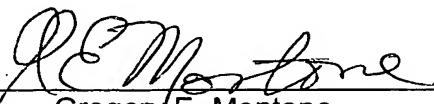
To the extent necessary, Applicants petition for an extension of time under 37

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CFR 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to the Antonelli, Terry, Stout & Kraus, LLP Deposit Account No. 01-2135 (Docket No. 503.34065CV4), and please credit any excess fees to such deposit account.

Respectfully submitted,
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